

REMARKS

Applicant has carefully reviewed the Office Action mailed June 27, 2003. By this Amendment, claims 2 and 10 are canceled and claims 1, 4, 9, 11 and 13 are amended. Claims 1, 4-9 and 11-32 are pending in this application. It is noted that Applicant has amended and cancelled the above-identified claims solely to advance prosecution of the instant application and to obtain allowance on allowable claims at the earliest possible date. Accordingly, no admission may be inferred from the amendments of claims herein. Applicant expressly reserves the right to pursue the originally filed claims in the future.

Claim 1 was rejected under 35 U.S.C. 103(a) as being unpatentable over Adams, Jr. et al (5866260) in view of Leavitt Sr. et al (4940622).

Applicant's invention as recited in amended claim 1 is a method including the steps of providing a pane having a surface and a masking material for forming a protective covering on the surface of the pane. Applicant's claimed method also includes the step forming a protective covering by applying a plurality of masking material strips onto the surface of the pane in a sequentially overlapping fashion. Additionally, Applicant's claimed method includes the step of forming a tab by folding the substrate of at least one strip of the masking material so that a first portion of the substrate overlaps a second portion of the substrate.

Because neither Adams, Jr. nor Leavitt, Sr. teach the step of folding a substrate of a masking material so that a first portion of the substrate overlaps a second portion of the substrate, these references do not teach every element of Applicant's claimed invention. Folding the substrate in this way provides a tab that can be used for removing the protective covering. In light of the above discussion, Applicant respectfully submits that independent claim 1 is now in condition for allowance.

Claim 4 was rejected under 35 U.S.C. 103(a) as being unpatentable over Adams, Jr. (5866260) in view of Smith (5330232).

Applicant's invention as recited in amended claim 4 is a method including the steps of providing a pane having a surface and a masking material for forming a protective covering on the surface of the pane. Applicant's claimed method also includes the step of calculating a number of strips and an overlap dimension for forming the protective covering so that an unmasked portion of the surface of the pane will surround the protective covering.

Unlike Applicant's claimed method, figure 4 of Smith teaches a single label 28 including an adhesive that is pressed into contact with the inside surface of a window 30 (column 3, lines 56-59). The fact that Smith only discloses a single label applied to a window shows that Smith does not teach the step of calculating a number of strips and an overlap dimension for forming a protective covering sized so that an unmasked apron surrounds the protective covering.

Also unlike Applicant's claimed method, figure 2 of Adams, Jr. shows a surface 20 covered with a single body of masking material 22. The fact that Adams, Jr. teaches the covering of a surface with a single body of masking material shows that Adams, Jr. does not teach the step of calculating a number of strips and an overlap dimension for forming a protective covering sized so that an unmasked apron surrounds the protective covering.

Because neither Adams, Jr. nor Smith disclose the step of calculating a number of strips and an overlap dimension for forming a protective covering sized so that an unmasked apron surrounds the protective covering, these references do not teach every step of Applicant's claimed method. Applicant's claimed method allows panes of various sizes to be masked using multiple strips from a single supply of masking material. This improvement is not suggested by either Adams, Jr. or Smith because these references do not disclose the use of multiple strips.

For these reasons, Applicant respectfully submits that claim 4 is now in condition for allowance. Claims 5-8 depend from claim 4 and recite additional limitations; Applicant respectfully submits that these claims are also in condition for allowance.

Claim 9 was rejected under 35 U.S.C. 103(a) as being unpatentable over Adams, Jr. in view of Bigler.

Applicant's claimed invention, as recited in claim 9 is an assembly including an insulating glass unit and a protective covering disposed over a masked portion of a first surface of a first pane of the insulating glass unit. The protective covering comprises a plurality of strips disposed in a sequentially overlapping fashion with each subsequent strip overlapping a portion of the preceding strip by an overlap dimension. The overlap dimension is selected so that an unmasked apron of the first surface extends between an outer periphery of the protective covering in an outer periphery of the pane.

As noted by the Examiner on page 5 of the present office action, Adams, Jr. does not show a protective covering comprising a plurality of strips. The fact that Adams, Jr. does not teach the use of multiple strips shows that this reference does not teach or suggest a subsequent strip overlapping a preceding strip by an overlap dimension.

Figure 1 of Bigler shows fabric strips 3, 4, 5, 6, etc. covering the entire surface of a roof. The fact that Bigler teaches a roof that is completely covered with strips shows that this reference does not teach or suggest a subsequent strip overlapping a preceding strip by an overlap dimension selected so that an unmasked apron of the surface of a pane extends between an outer periphery of the protective covering and an outer periphery of the pane.

Because neither Adams, Jr. nor Bigler disclose a subsequent strip overlapping a preceding strip by an overlap dimension selected so that an unmasked apron of the surface of a

pane extends between an outer periphery of the protective covering and an outer periphery of the pane, these references do not disclose all elements of Applicant's claimed invention. Accordingly, Applicant respectfully submits that independent claim 9 is now in condition for allowance. Claims 11-25 depend from claim 9 and recite additional limitations; Applicant respectfully submits that these claims are also in condition for allowance.

Claim 26 was rejected under 35 U.S.C. 103(a) as being unpatentable over Adams, Jr. (5866260) in view of Bigler (1284997).

Applicant's claimed method as recited in claim 26 is a method comprising the steps of calculating a number of strips and an overlap dimension for forming a protective covering dimensioned so that an unmasked apron of a surface of a pane surrounds the protective covering. A protective covering formed in this manner allows the unmasked apron to receive a sash while, at the same time, protecting a portion of the pane that is not covered by the sash.

As noted by the Examiner on page 10 of the present office action, Adams, Jr. does not show the step of calculating a number of strips and an overlap dimension for forming a covering sized so that an unmasked apron of the surface surrounds the covering.

Figure 1 of Bigler shows fabric strips 3, 4, 5, 6, etc. covering the entire surface of a roof. The fact that Bigler teaches a roof that is completely covered with strips shows that this reference does not teach or suggest the step of calculating a number of strips and an overlap dimension for forming a covering sized so that an unmasked apron of the surface surrounds the covering.

For the reasons described above, neither Adams, Jr. nor Bigler teach the step of calculating the step of calculating a number of strips and an overlap dimension for forming a covering sized so that an unmasked apron of the pane surrounds the covering. Because the combination of Adams, Jr. and Bigler does not teach every step of Applicant's claimed method, this combination of references cannot render Applicant's claimed invention obvious. Accordingly, Applicant respectfully submits

that independent claim 26 is now in condition for allowance. Claims 27, 28, and 32 depend from independent claim 26 and recite additional limitations. Applicant respectfully submits that these dependent claims are also in condition for allowance.

Claim 29 was rejected under 35 U.S.C. 103(a) as being unpatentable over Adams, Jr. (5866260) in view of Smith (5330232). Smith discloses a method for the production of labels which are printed with non-variable indicia, and then sent to an ultimate user site for the printing of variable indicia (column 1, lines 13-17). The label may be put on a transparent surface like a store window or the windshield of a vehicle (column 1, lines 6-9). The disclosure of Adams, Jr. is described above.

Applicant's invention as recited in amended claim 29 is a method comprising the steps of applying a protective covering to a pane, attaching an information bearing sheet to the protective covering, and transporting the information bearing sheet and the window assembly to a point of use.

Unlike Applicant's claimed invention, neither Adams, Jr. nor Smith teach the step of transporting a window assembly to a point of use. Because the combination of Adams, Jr. and Smith does not teach every step of Applicant's claimed method, this combination of references cannot render Applicant's claimed invention obvious. Accordingly, amended independent claim 29 is now in condition for allowance. Claims 30-31 depend from independent claim 29 and recite additional limitations. Applicant respectfully submits that these dependent claims are also in condition for allowance.

In light of the above discussion, Applicant respectfully submits that all of the claims are in condition for allowance and courteously requests prompt notice of the same. If a telephone conference would be of assistance, please contact the undersigned practitioner at 612/492-7000.

Respectfully submitted,



Allen W. Groenke
Registration No. 42,608

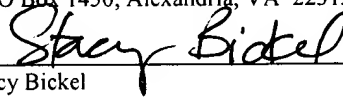
Customer No. 22859
Fredrikson & Byron, P.A.
4000 Pillsbury Center
200 South Sixth Street
Minneapolis, MN 55402-1425 USA
Telephone: (612) 492-7000
Facsimile: (612) 492-7077

Please grant any extension of time necessary for entry; charge any fee due to Deposit Account No. 06-1910.

CERTIFICATE OF MAILING

I hereby certify that this document is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 on

December 23, 2003
Date of Deposit


Stacy Bickel

#2834538\2